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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/692,950

10/27/2003

Kentaro Fujino

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7590

05/02/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
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EXAMINER

KNABLE, GEOFFREY L

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

05/02/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/692,950	Applicant(s) FUJINO ET AL.	
	Examiner Geoffrey L. Knable	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-30 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/21/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claim 27 (which corresponds to previous non-elected claim 11) is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the election requirement in the reply filed on 4-24-2006.
3. Claims 19-26, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US 5,292,590) taken in view of JP 63-8448.

These references are applied for the same reasons as set forth in the last office action with respect to corresponding claims 1, 3-10 and 14. It is stressed that the teachings of JP '448 with respect to improving water resistance, and thereby avoiding decreases in the barrier properties in humid environments, of EVOH film materials would have been understood as applicable and advantageous for tire innerliners where particularly harsh environmental exposure would have been expected.

4. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US 5,292,590) taken in view of JP 63-8448 as applied above, and further in view of at least one of [Liu et al. (US 5,280,817) and Weston et al. (US 5,879,488)].

These secondary references are applied for the same reasons as set forth in the last office action with respect to corresponding claims 18.

5. Applicant's arguments and Terminal Disclaimer filed 2-11-2008 have been fully considered and are sufficient to overcome all but the rejections maintained above.

With respect to this remaining rejection, it is argued that Lin et al. does not suggest modified EVOH as claimed and JP '448 does not suggest improving flex resistance or use in a pneumatic tire. This argument has been carefully considered but is unpersuasive as it is still considered that the artisan would have been motivated to modify EVOH in an innerliner in the claimed manner with an expectation of improving the water resistance thereof and thereby reducing decreases in barrier properties in humid environments. As set forth above, it is submitted that such improvements would have been understood as applicable and advantageous for tire innerliners where particularly harsh environmental exposure would have been expected.

Applicant has also pointed to comparative data in the specification (esp. Table 1) showing the superiority of the invention as compared to unmodified EVOH, especially with regard to the ability to retain pressure after driving. While these results do illustrate important improvements in pressure retainability after driving, it is not clear that these results are reasonably commensurate with the broad scope of the present claims. Note for example that the present claims are inclusive of *any* monofunctional epoxy compound whereas the results seem to illustrate at most two different epoxy compounds and it has not been convincingly argued why these results should have predictably been expected to apply for any other epoxy compound. Given that these examples all use cross-linked copolymers, it is also not clear that similar results should be expected for uncross-linked materials. As such, these results are on balance at present insufficient to overcome the prior art rejection of the present claims.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey L. Knable/
Primary Examiner, Art Unit 1791

G. Knable
April 27, 2008